

**REMARKS/ARGUMENTS**

Claims 1-54 were pending in the instant application prior to amendment. Claims 55-59 were added in this Response. Claims 25-26 were cancelled previously, and various claims as discussed above have been amended. The claims pending at this time are therefore claims 1-24 and 27-59. Claims 10-24 and 27-54 have been withdrawn from consideration on the basis that they are drawn to a non-elected invention, and claims 1-9 therefore stand rejected on various grounds with new claims 55-59 having not yet been examined. The objections and rejections are addressed in the appropriate sections below. Applicant specifically reserves the right to pursue the subject matter of original claim 1 as well as cancelled claims 25 and 26 in a continuing application claiming the benefit of the present application.

The present application is believed to be in condition for allowance.

**35 U.S.C. § 112, Second Paragraph**

Claims 1-9 stand rejected under 35 U.S.C. § 112, second paragraph for allegedly being indefinite as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner's suggested amendments have been adopted. Applicants note that the amendments do not narrow the scope of the claims. Applicants believe that all the grounds of indefiniteness have been adequately addressed in order to overcome the rejections. Therefore, it is respectfully requested that these rejections under §112, second paragraph, be withdrawn.

**35 U.S.C. § 103(a)**

Claims 1-9 stand rejected under 35 U.S.C. § 103 as being allegedly obvious over Wollowitz et al. (U.S. Pat. No. 5,593,823) in view of Tsyurupa et al. and Davankov et al. Applicants respectfully traverse the rejection.

Applicant submits that the subject matter from Wollowitz et al. upon which the examiner bases his rejection is the inventor's own work. The attached declaration of Derrick J. Hei under 37

C.F.R. 1.132 explains that Mr. Hei invented the subject matter used as the basis of the examiner's rejection. The Wollowitz et al. patent therefore does not qualify as subject matter developed by another.

Further, the rejection of joint inventor Mr. Cimino's contribution to one or more of the dependent claims is improper under 35 U.S.C. Sec. 103(c). 35 U.S.C. Sec. 103(c) states that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability ... where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

Amended 35 U.S.C. Sec. 103(c) applies to those patent applications filed on or after November 29, 1999. The present application was filed January 16, 2002.

Wollowitz et al. issued January 14, 1997, while the presently-claimed subject matter claims the benefit of application 08/484,926 filed June 7, 1995 and a subsequent CIP application 08/660,910 filed June 7, 1996 as well as continuation application 09/537,962 filed March 28, 2000. Wollowitz et al. published after the CIP '910 application was filed and is therefore not available as prior art against the present application under the provisions of 35 U.S.C. Sec. 102(a). The only remaining provisions under which the Wollowitz et al. patent might qualify as prior art to the present application are 35 U.S.C. Sec. 102(e), (f), or (g).

The subject matter of the present invention as well as the portion of the Wollowitz et al. patent cited by the Examiner were both owned by the same person, or the inventors were under an obligation to assign to the same person at the time the invention was made. The inventors of the present invention were employees of Steritech Inc. at the time the invention was made and had an obligation to assign to Steritech Inc. Inventor Derek J. Hei assigned his interest in the parent application 08/484,926 to Steritech Inc., which assignment was recorded October 6, 1995 at reel 7701 frame 0683. Steritech Inc. became the present assignee, Cerus Corporation, on September 9, 1996 when its corporate articles were amended to change the company name (see the change of name recorded November 18, 1996 at reel 8222 frame 0718). Cerus Corporation and Steritech Inc.

are therefore the same person for purposes of 35 U.S.C. Sec. 103(c). Inventor Derek J. Hei executed a second assignment for 08/484,926 contemporaneously with inventor George D. Cimino's and Stephen T. Isaacs' assignment to Cerus Corporation, which was recorded October 22, 1997 at reel 8797 frame 0565.<sup>1</sup> The Wollowitz et al. patent assignments to Steritech Inc. were recorded February 9, 1995 at reel 7382 frame 0590, and are therefore evidentiary of the Wollowitz et al. patent being likewise owned by Steritech Inc. at the time the invention was made. The cited subject matter in the Wollowitz et al. patent and the claimed invention were therefore, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person as specified by 35 U.S.C. Sec. 103(c).

All conditions of 35 U.S.C. Sec. 103(c) are met, and therefore the Wollowitz et al. patent is not available to reject under 35 U.S.C. Sec. 103(a) any of the claimed subject matter which Mr. Cimino contributed.

Applicant consequently respectfully requests withdrawal of the rejection and allowance of the examined claims.

#### Rejection of claims 25 and 26

Claims 25 and 26 were cancelled previously (please refer to the response mailed August 20, 2003). The rejection of these claims is therefore moot.

#### Provisional obviousness-type double patenting rejection

Claims 1-9, 25 and 26 stand provisionally rejected under the judicially created doctrine of double patenting to U.S. Patent Application No. 09/972,323 or 10/011,202. Claims 25-26 were cancelled, rendering a portion of the rejection moot. Applicant notes the provisional nature of the rejection with respect to pending claims 1-9 and will address the rejection at the appropriate time once the rejection is no longer provisional. Applicant wishes to bring to the Examiner's attention U.S. Pat. No. 6,544,272 (cited in the accompanying form PTO-1449) to assure its consideration.

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<sup>1</sup> Mr. Isaacs was removed from the list of inventors in a subsequent communication with the Patent Office.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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Respectfully submitted,

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